

MORGAN L. FITCH, JR.  
FRANCIS A. EVEN  
JULIUS TABIN  
JOHN F. FLANNERY  
ROBERT B. JONES  
JAMES J. SCHUMANN  
JAMES J. HAMILL  
TIMOTHY E. LEVSTIK  
JOSEPH E. SHIPLEY  
KENNETH H. SAMPLES  
PHILIP T. PETTI  
JOSEPH T. NABOR  
STEVEN C. SCHROER  
RICHARD A. KABA\*  
KARL R. FINK  
MARK W. HETZLER  
TIMOTHY P. MALONEY  
JAMES P. KRUEGER  
STEPHEN S. FAVAKEH  
EDWARD W. GRAY, JR.  
RICHARD E. WAWRZYNIAK\*  
STEVEN G. PARMELEE\*  
SHERRI N. BLOUNT\*  
BRUCE R. MANSFIELD  
KENDREW H. COLTON\*  
G. PAUL EDGELL  
RICHARD W. SCHUMACHER  
MICHAEL A. SANZO\*



# FITCH, EVEN, TABIN & FLANNERY

ATTORNEYS AND COUNSELLORS AT LAW

Established in 1859

SUITE 1600 - 120 SOUTH LA SALLE STREET  
CHICAGO, ILLINOIS 60603-3406

TELEPHONE (312) 577-7000

FACSIMILE (312) 577-7007

## CALIFORNIA OFFICE

SUITE 250 - 9276 SCRANTON ROAD, SAN DIEGO, CA 92121-7707

TELEPHONE (858) 552-1311

## WASHINGTON, D.C. OFFICE

SUITE 401L - 1801 K STREET, NW, WASHINGTON, D.C. 20006-1201

TELEPHONE (202) 419-7000

## COLORADO OFFICE

SUITE 213 - 1942 BROADWAY, BOULDER, COLORADO 80302

TELEPHONE (303) 402-6966

CHRISTOPHER E. GEORGE\*  
SCOTT J. MENGHINI\*  
EDWARD E. CLAIR  
SANDRA V. SCAVO  
JON A. BIRMINGHAM  
RUDY KRATZ  
RAMON R. HOCH\*  
JOHN E. LYHUS  
STEVEN M. FREELAND\*  
DONNA E. BECKER  
SEAN R. O'DOWD\*  
MICHAEL G. VRANICAR  
BRIAN S. CLISE\*  
MARTIN R. BADER\*  
DEREK L. PRESTIN  
MARK A. BORSOS  
DAVID R. JAGLOWSKI  
W. BRIAN EDGE

## PATENT AGENTS

ERIC J. WHITESELL  
JONATHAN H. BACKENSTOSE  
LILIA I. SAFONOV

## OF COUNSEL

THOMAS F. LEBENS  
GEORGE W. SPELLMIRE, JR.  
LISA M. SOMMER

\*NOT ADMITTED TO ILLINOIS BAR

Examiner Ruth S. Smith  
Art Unit 3737  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

*Action has been forwarded to the correct address of 10/3/03. 7/10/10*  
October 2, 2003  
**RECEIVED**  
OCT 09 2003  
TECHNOLOGY CENTER R3700

Dear Examiner Smith:

Enclosed is the office action that we spoke about today which was mistakenly sent to our firm.

Very truly yours,

FITCH, EVEN, TABIN & FLANNERY

By

*Patricia F. Jones*  
Patricia F. Jones  
Docket Supervisor

Enclosure



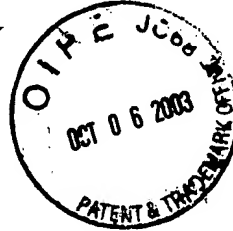
# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,430	08/10/2000	Graeme C. McKinnon	S13.12-0106	7290

22242 7590 09/26/2003

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406



EXAMINER

SMITH, RUTH S

ART UNIT PAPER NUMBER

3737

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
OCT 09 2003  
TECHNOLOGY CENTER R3700

RECEIVED  
FITCH, EVEN, TABIN  
SEP 29 2003

# Office Action Summary



Application No.

09/804,430

Applicant(s)

MCKINNON, GRAEME C.

Examiner

Ruth S Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 is/are allowed.
- 6) ☒ Claim(s) 28-34, 41-51 and 53-64 is/are rejected.
- 7) ☒ Claim(s) 35-39 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

RECEIVED

OCT 09 2003

TECHNOLOGY CENTER R3700

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Specification***

The disclosure is objected to because of the following informalities: In column 6, line 1, "140" should be "14". Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

Claims 29,30,42,45,59 are objected to because of the following informalities: It is unclear as to how one "calculates" or "measures" an image. It appears that the image data is obtained and an image is obtained from the data. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28,31-34,40,46-49,54,56,59,64 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Robinson. The claims are directly readable on Robinson which discloses a coaxial cable placed within a catheter in order to image blood vessels in a body using MRI. The probe is coupled to an MRI system which inherently includes the structure of the controller and processor and means for generating fields as set forth. The structure set forth by Robinson inherently is capacitively coupled to an EM

Art Unit: 3737

field generated by the EM radiation. The structure of the probe of Robinson inherently provides a guidewire in that the coaxial cable is capable of functioning as such.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29,30,41-45,50,51,53,55,57-63 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson. Robinson which discloses a coaxial cable placed within a catheter in order to image blood vessels in a body using MRI. The probe is coupled to an MRI system which inherently includes the structure of the controller and processor and means for generating fields as set forth. Applicant discloses that it is well known in the art to determine antenna location from the detected MR signals. Furthermore, it is old and well known in the art to repeatedly obtain the MR signals for use in imaging a part of a patient. It would have been obvious to one skilled in the art to have determined antenna position and orientation from the detected signals using known data processing techniques in order to accurately determine if the image is obtained from a desired location in the patient. Furthermore, it would have been obvious to one skilled in the art to repeatedly acquire the data in order to provide a high-resolution image as is also a well known expedient in the art.

***Allowable Subject Matter***

Claims 1-27 are allowable over the prior art of record.

Claims 35-39,52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3737

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Ruth S Smith  
Primary Examiner  
Art Unit 3737

RSS



# Notice of References Cited

Application/Control No.

09/804,430

Applicant(s)/Patent Under  
Reexamination  
MCKINNON, GRAEME C.

Examiner

Ruth S Smith

Art Unit

3737

Page 1 of 1

## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,347,221	09-1994	Rubinson, Kenneth A.	600/423
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

RECEIVED

OCT 09 2003

TECHNOLOGY CENTER R3700

## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

84